

Moreover, dependent claim 26 was listed as allowed on the Summary page, yet claim 25 (from which it depends) is rejected for a specific reason provided in the Office Action. In addition, the status of the pending claims becomes even more confused, as it is indicated that claims 25 and 26 are allowable on page 3 of the Office Action.

Applicants respectfully request careful reconsideration and characterization of the pending claims.

## **II. Discussion of the Rejection of Claim 14 under 35 U.S.C. Sec. 112, First Paragraph**

Claim 14 has been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly lacking enablement for not reciting specific reaction conditions. Applicants respectfully traverse this rejection.

Applicants assert that since temperature and pressure are not critical to the practice of the invention, it is unnecessary to recite them in claim 14.

The process set forth in claim 14 is described in detail in the specification on pages 50 – 54 *inter alia*, as Process 1.

Since the reaction conditions mentioned by the Examiner are not critical to the recited process, and since the process is well-described in the specification, Applicants respectfully request withdrawal of the Sec. 112, first paragraph rejection of claim 14.

## **III. Discussion of the Rejection of Claims 12 and 25 under 35 U.S.C. 112, Second Paragraph**

Claims 12 and 25 have been rejected under 35 U.S.C. Sec. 112, second paragraph as allegedly indefinite. Applicants respectfully traverse the rejection, and assert that those skilled in the art would understand their invention as set forth in claims 12 and 25. The objections related to each claim will be discussed separately.

### *Objections to Claim 12*

The Examiner has objected to the bracket appearing in the formula for claim 12. Those skilled in the art of organic chemistry understand that the bracket indicates that the -OR<sup>4</sup>

substituent may be found at either position C4 or C5 on the bicyclic ring. Page 41, lines 23-27 illustrate one of the possibilities, wherein R<sup>4</sup>-X- is substituted on the C5 position. In addition, pages 103-105 summarize the examples of the specification. On these pages, C4 and C5 substituents are represented by the symbols f and e respectively. One skilled in the art would understand that the bracket between the -OR<sup>4</sup> and the bicyclic ring indicates that the OR<sup>4</sup> substituent can be at either C4 or C5 of the bicyclic ring. Therefore, Applicants believe that the use of the bracket as a symbol in the general formula of claim 12 is sufficiently clear.

The Examiner apparently wishes to object to the oxygens as symbolized in the general formula of claim 12. Applicants submit that it is indeed sufficiently clear to one skilled in the art that there are two oxygens in the general formula. Page 44, line 25 – page 45, line 21 describes the compounds recited in claim 12, clearly showing two oxygens in the general formula.

For these reasons, Applicants believe pending claim 12 is already sufficiently clear to one skilled in the art of organic chemistry.

#### *Objections to Claim 25*

The Examiner has objected to part of the definition of the R<sup>4</sup> variables in claim 25: that portion which states “which hydrocarbon group is optionally further substituted”. As the Examiner has recognized, the R<sup>4</sup> hydrocarbon group is substituted by an aromatic group, but as the phrase in question indicates, it can have other substituents besides the aromatic group. These further substituents are described in the specification at page 37, lines 17-21 *inter alia*.

The Examiner has also objected the phrase “optionally further substituted apart from the group of the formula: -X-R<sup>4</sup>” under the definition of ring A in claim 25 as allegedly indefinite. However, Applicants assert that this phrase would be well understood by those skilled in the art, especially given the teaching of the specification at page 39, lines 22-30 *inter alia* concerning this matter.

For these reasons, Applicants believe pending claim 25 is already sufficiently clear to one skilled in the art of organic chemistry.

Therefore, Applicants respectfully request withdrawal of the Sec. 112, second paragraph rejection of claims 12 and 25.

#### IV. Discussion of Claim 22

Applicants wish to point out to the Examiner that the general formula which had appeared in claim 22 was to be removed from the claim by the previous amendment. In case the line drawn through the general formula did not appear in the Examiner's copy of the previous amendment, Applicants respectfully request the Examiner to check the claim to be sure that the general formula has been accurately deleted. If the general formula has not yet been deleted, Applicants authorize the Examiner to delete it by Examiner's amendment. The Examiner's assistance in this matter is appreciated.

#### V. Conclusion

Reconsideration of the claims and allowance is requested.

Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, she is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

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